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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,321	09/24/2003	James D. King	2170-1-3	5658

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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,321

Applicant(s)

KING, JAMES D.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 42-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 and 42-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 61 be found allowable, claim 62 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 13-17, 19-28, 32, 33, 36-38, 42-48, 50-58 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson in view of Ottrando.

Jackson discloses in Figures 1 and 2 and in the specification a goal tracking system comprising a substrate comprising a surface having a plurality of areas including a title area, a goal statement area and an activity area defining a sports activity, where each area has permanent markings related to the areas as recited. Jackson fails to disclose a movable activity symbol for tracking progress. Ottrando discloses in Figure 1 and in the specification a goal tracking system comprising an activity area having a movable activity symbol removably retained thereon, where the symbol is moved to demonstrate progress towards a goal. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Jackson by providing a movable activity symbol for the purpose of allowing a user to easily track progress toward a goal, particularly since Jackson discloses indicia relating to "yards" being gained as progress towards a "touchdown", to indicate a goal being achieved. With respect to claims 2, 14, 21, 44 and 55, the substrate of Jackson is inherently erasable. The use of an erasable writing implement such as a pencil is an obvious variation on the teachings of Jackson, as such implements are well known. With respect to claim 3 and 22 as noted above

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Jackson discloses that the writing relates to yards, and thus defines a correlation between achieving a step of the goal and movement along the sports activity field. With respect to claims 4-7, 23-26, 43 and 54, the daily chores shown in Figure 2 are short term and medium term goals. With respect to claims 8 and 27 the indicia reading "Responsible Football League" is considered to be a positive slogan. With respect to claims 9, 28, 45 and 56, the small football fields of Jackson are considered to be a scorekeeping area. It should also be noted with respect to claims 2-9 that the content of printed indicia will not overcome the prior art where there is no new and nonobvious functional relationship between the indicia and the underlying substrate. See *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Even if Jackson did not disclose or suggest the content of the printed indicia as recited, the claims still would not be allowable for this reason. With respect to claims 13, 32 and 57, as noted above Jackson discloses a football field, where progress towards a touchdown is tracked. With respect to claims 33, 46 and 57, the teachings of Jackson as viewed with those of Ottrando suggest the use of a football as the movable activity piece. With respect to claims 15, 16, 36, 38, 50, 52, 61, 62 and 64, hook and loop systems and computer displays are well known, and are considered to be obvious variations on the teachings of Ottrando. With respect to claims 17, 37, 51 and 63, Ottrando discloses that its display comprises a magnetic board, where the movable activity piece 30 is a magnet capable of being moved along the path. Claims 19, 38, 47 and 58 are rejected because the indicia does not overcome the prior art under *In re Ngai* as discussed above. The method of claims 42 and 53 is suggested by the

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combined teachings of the references, as Jackson discloses writing goals and tracking progress using a sports activity field, and Ottrando discloses moving an activity symbol to track progress towards a goal. With respect to claims 48 and 59, the time period recited is an obvious variation on the teachings of Jackson as viewed with Ottrando.

Claims 10, 11, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson in view of Ottrando, and further in view of Leahy. Jackson as viewed in combination with Ottrando discloses all of the claimed limitations with the exception of the tray for holding the writing implement. This is a well known feature of writing boards, as disclosed for example by Leahy. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Jackson as viewed in combination with Ottrando by providing a tray for the purpose of holding the writing implement.

Claims 10, 12, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson in view of Ottrando, and further in view of Zand. Jackson as viewed in combination with Ottrando discloses all of the claimed limitations with the exception of the tray for holding the writing implement. The holding device 26 disclosed by Zand is considered to be an obvious variation on a hook, as it performs the identical function of holding a writing implement. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Jackson as viewed in combination with Ottrando by providing a hook for the purpose of holding the writing implement.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson in view of Ottrando, and further in view of Staadecker. Jackson as viewed in combination with Ottrando discloses all of the claimed limitations with the exception of the magnetic dry erase board. This is a known feature of writing boards, as disclosed for example by Staadecker. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Jackson as viewed in combination with Ottrando by providing a magnetic dry erase board for the purpose of allowing a user to write on the surface and also move a magnetic piece along the board.

Claims 34, 35, 49, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson in view of Ottrando, and further in view of Yamamoto. Jackson as viewed in combination with Ottrando discloses all of the claimed limitations with the exception of the rubber stamp. It is known to provide erasable ink with a rubber stamp, as disclosed for example in column 3, lines 40-43 of Yamamoto. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Jackson as viewed in combination with Ottrando by providing a rubber stamp and erasable ink pad for the purpose of allowing a user easily mark the surface with selected erasable indicia.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bason, Thurman, Labrot, Fruge and Evans disclose various


devices and methods for tracking goals and behaviors. Metheny and Webber disclose writing boards having movable magnetic markers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M, T, Th 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KF
November 27, 2006


KURT FERNSTROM
PRIMARY EXAMINER